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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,363	07/29/2003	George R. Petersen		6257

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Mr. George Patersen
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EXAMINER

QIN, JIANCHUN

ART UNIT PAPER NUMBER

2837

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

✓ A EIC

Office Action Summary	Application No. 10/629,363	Applicant(s) PETERSEN ET AL.	
	Examiner Jianchun Qin	Art Unit 2837	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/29/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

Drawings

2. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

Claims 1-9 are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Claims 1-9 contain merely functional language and intended uses of the claimed invention, but, since the claims do not set forth any active method steps to clearly define the claimed invention, it is unclear what method/process applicant is intending to encompass. A process/method must contain active, positive steps with the phrase "comprising the steps of:" followed by active steps involved in the method/process.

Regarding claims 4-6, 8 and 9, the phrases "such as", "can be", "In such cases" and "any other language" render the claims indefinite because it is unclear whether the limitations following the phrases are part of the claimed invention. See MPEP § 2173.05(d).

Regarding independent claims 5, 6, 8 and 9, the abbreviation "USPM" has to be clearly defined and spelled out.

Art Unit: 2837

Regarding claims 1-9, the Applicants are advised that anything enclosed in the parenthesis (e.g., claim 2, line 6) is not considered as part of the claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Milburn et al. (U.S. Pat. No. 6051770).

With respect to claim 1, Milburn et al. teach a melodic interchange process/method (see Abstract), that is grounded in common-mode scansion-- essentially common rhythmic links existing between otherwise dissimilar musical works (col. 6, lines 38-46; col. 7, lines 59-63; col. 10, lines 21-25), wherein said process uses new, original written text containing a plurality of structured rhythmic prosody employing common-mode scansion that is divisible within a standard musical form (col. 6, lines 38-46; col. 7, lines 32-36, lines 59-63; col. 8, lines 13-31; col. 10, lines 21-25), thus allowing persons having no previous musical training or musical sight-reading skill to perform newly-authored lyrical creations (see Abstract).

With respect to claim 2, the teaching of Milburn et al. further includes: said process/method is designed with written/displayed text(s) containing rhythmic prosody structured on common-mode scansion, thus enabling said new lyrics to be

Art Unit: 2837

superimposed over melodic material that is familiar to the user (col. 6, lines 38-46; col. 8, lines 13-31; col. 10, lines 21-25). These can exist as a single (or a plurality of) short or long lyrical piece(s), combined with a textual song list and/or sound playback system containing instrumental compositions that follow the same common-mode scansion as the lyrics (col. 6, lines 38-46; col. 7, lines 32-36, lines 59-63).

With respect to claim 3, the teaching of Milburn et al. further includes: said process/method capitalizes on the user's knowledge of well-known melodies - ranging from simple nursery rhymes to elaborate classical works that are previously known to the user (col. 7, lines 59-63). By authoring new lyrics to the composition model taught by Milburn et al., the resulting lyrics can be performed with thousands of existing tunes (col. 10, lines 21-25; Abstract, lines 10-12).

With respect to claim 4, the teaching of Milburn et al. further includes: said process/method includes formats such as: textual material(s) in book or as traditional paper-bound electronic form, whether books, cards, leaflets and/or song-sheets, or as electronic media--i.e., CDs, DVD-A, DVD-V, SACD, DVD-ROMS, Internet CD-ROMS, files, videotapes, diskettes, encoded ROM/RAM chips for solid-state storage/playback devices, mixed media disks--such as interactive computer files combined with instrumental musical compositions in audio and/or MIDI (Musical Instrument Digital Interface) formats, Karaoke-style disks/files and the like (col. 3, lines 8-26; cols. 6-7, lines 65-23).

Claims 5-9 recite applications of the process/method taught by Milburn et al. discussed above. They are merely intended uses of the invention of Milburn et al. It has

Art Unit: 2837

been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Prior Art Citations

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- 1) Georges et al. (U. S. Pat. No. 6815600) is entitled to "Systems and methods for creating, modifying, interfacing with and playing musical compositions".
- 2) Pachet (U. S. Pub. No. 20020005110) is entitled to "Rhythm feature extractor".
- 3) Phillips (U. S. Pub. No. 20040200335) is entitled to "Musical invention apparatus".
- 4) Bruti et al. (U. S. Pat. No. 5679913) is entitled to "Electronic apparatus for the automatic composition and reproduction of musical data".
- 5) Miyashita et al. (U. S. Pat. No. 5466883) is entitled to "Karaoke reproducing apparatus".

Art Unit: 2837

Contact Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jianchun Qin whose telephone number is (571) 272-5981. The examiner can normally be reached on 7am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on (571) 272-2107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JQ

May 10, 2005

Jianchun Qin
Examiner
Art Unit 2837



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